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OFFICE OF PETITIONS

In re Application of
Douglas A. Collins et al.
Application No. 10/620,273
Deposited: July 15, 2003
Attorney Docket No. 07959.105018 DIV
Title: RADIONUCLIDE LABELING OF
VITAMIN B12 AND COENZYMES
THEREOF

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DECISION ON RENEWED PETITION
UNDER 37 C.F.R. §1.182

BACKGROUND

This is a decision on the renewed petition under 37 C.F.R. §1.182, requesting that the above-identified application be accorded a filing date of July 15, 2003, with Figures 1 and 2 as part of the original disclosure of the application.

The application was deposited July 15, 2003. However, on December 3, 2003, the Office of Initial Patent Examination (OIPE) mailed a notice stating that the application had NOT been accorded a filing date, and advising applicants that the application appeared to have been deposited without drawings, and that a filing date would be accorded upon the depositing of drawings.

With the original petition, received on February 3, 2004, Petitioner submitted copies of Figures 1 and 2, along with the petition fee and an assertion that a Preliminary Amendment was included on filing which indicates that the instant application is a divisional of 09/626,213 (which issued as 6,613,305 on September 2, 2003), and that the entire disclosure of which was incorporated by reference^{1,2}. Petitioner concluded that Figures 1 and 2 were constructively included on filing, through incorporation by reference.

¹ Response, page 1.

² It is noted that this Preliminary Amendment has been located in the electronic file, and it does set forth both the continuity and the incorporation by reference.

The original petition was dismissed via the mailing of a decision on April 5, 2004. The decision set forth:

The drawings in question were required to secure a filing date. As such, they may not be incorporated by reference, pursuant to the portion of the MPEP reproduced immediately above [MPEP 201.06(c)]. Petitioner properly submitted a petition under 37 C.F.R. §1.182, the required drawings, and the associated petition fee. However, Petitioner has not submitted an amendment requesting that the drawings be entered into the instant application.

Furthermore, Petitioner has not submitted a newly executed oath or declaration, as required by the Notice, and has set forth that such is not required as the drawings do not constitute new matter³. Unfortunately, a new oath or declaration will be required. Pursuant to MPEP §§608.02(h) and 608.04, the Examiner will eventually review these drawings to determine whether they constitute new matter, and if it is determined that they constitute new matter, they will not be entered. As such, it is not within the jurisdiction of the undersigned to determine whether the drawings constitute new matter, and a newly executed oath or declaration is required.

ANALYSIS

With the renewed petition, Petitioner has included an amendment which requests the entry of the drawings into the present application, along with a newly executed declaration, a three-month extension of time, and a petition fee for the renewed petition. Since there is no fee associated with the filing of a renewed petition, the petition fee has been refunded to Petitioner's Deposit Account.

CONCLUSION

As the previously indicated deficiencies have been corrected, the petition is GRANTED.

The application will be forwarded to Technology Center 1600 for further processing of the amendment filed concurrently with the renewed petition. The amendment will be reviewed by the examiner for new matter⁴. The amendment is not new matter if the substance was a part of the disclosure of the prior application

The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282. Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.



Paul Shanowski
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Office of Petitions
United States Patent and Trademark Office

³ Response, page 1.

⁴ See MPEP 608.02(h) and 608.04.